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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 09/684,075 | 10/08/2000 | John Fors | 0544MH-36340 | 2874 |
| 7590 | 10/02/2003 | | EXAMINER | |
| Christopher W. Kennerly, Esq. Baker Botts LLP 2001 Ross Avenue Suite 600 Dallas, TX 75201-2980 | | | ROBINSON BOYCE, AKIBA K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3623 | |
| DATE MAILED: 10/02/2003 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/684,075 | FORS, JOHN | |
| | Examiner Akiba K Robinson-Boyce | Art Unit 3623 | |

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 October 2000.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Status of Claims

1. Due to communications filed 10/8/00, the following is a first action, non-final office action. Claims 1-6 are pending in this application and have been examined on the merits. Claims 1-6 are rejected as follows.

Claim Objections

2. Claim 1 is objected to because of the following informalities: In claim 1, line 5, "for each pf a set pf possible" should read "for each of a set of possible". In claim 1, line 12, "wherein the schedule provides fro product development" should read "wherein the schedule provides product development". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "resource constraints" in claim 1 is a relative term that renders the claim indefinite. The term "resource constraints" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the

invention. Because the term "resource constraints" is used, the entire claim and the scope of the invention unclear.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of :

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful art" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 is directed to a method for selecting a portfolio of products to be developed. Claim 1 recites the steps of "selecting a set of candidate products to be developed", "calculating a set of financial projections for each candidate product, the set providing a future profit determination for each of a set of possible

product introduction dates”, “providing at least one project definition for each candidate product, such project definitions each including a development schedule and resource requirements”, “providing a set of available resources”, and “generating a development schedule from the set of candidate products to maximize profit, wherein the schedule provides product development in accordance with project definition and resource constraints. These steps represent mere ideas in the abstract since they recite no machine or computer means to help carry out this method. Since no machine or computer means are present, claim 1 and all claims that depend from it are therefore found to be non-statutory subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Cherneff et al (US 6,233,493).

As per claims 1, 4, Cherneff et al discloses:

selecting a set of candidate products to be developed/ a set of candidate products; (Col. 9, lines 28-29, [selecting a sequence of products]);

calculating a set of financial projections for each candidate product, the set providing a future profit determination for each pf a set pf possible product introduction dates/ a set of financial projections associated with each candidate product, wherein the set provides a plurality of profit projections for each of a set of possible introduction dates for the associated candidate product, (Col. 3, lines 27-31[represented by financial measure and product introduction date is inherent since the product completion date is disclosed, which also is a measure of time for the launch of a product, in addition, Col. 2, lines 35-36, discloses the importance of incorporating product launch time], lines 60-63, [future aggregate plans]),

providing at least one project definition for each candidate product, such project definitions each including a development schedule and resource requirements/ at least one project definition associated with each candidate product, each of such product definitions including a development schedule and resource requirements, (Col. 3, Lines 17-22; [defining model instances represents the project definitions], Col. 2, lines 47-49, lines 52-54, [required tasks that use resources])

providing a set of available resources/ a set of available resources, (Col. 7, lines 55-58, [a resource available]); and

generating a development schedule from the set of candidate products to maximize profit, wherein the schedule provides for product development in accordance with project definition and resource constraints/ a planning engine for reading in the set of candidate products, the sets of financial projections, the project definitions, and the available resources, and selecting a set of candidate products which meets all resource availability constraints and maximizes profits, and for generating a development schedule for the selected set of candidate products, (Col. 4, line 54-Col. 5, line 3, [schedule building]).

As per claims 2, 5, Cherneff et al discloses:

wherein the project definitions include a plurality of ordered tasks, with each task containing a time requirement, a resource requirement, and an ordering constraint with respect to the other tasks in the project, (Col. 2, lines 52-54, [priority sequences, Col. 1, lines 24-26, [not missing deadlines], Col. 4, lines 41-44, [various constraints])

As per claims 3, 6, Cherneff et al discloses:

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wherein a candidate product includes at least two project definitions, and wherein the generating step includes the step of selecting one of the at least two project definitions in the development schedule, (Col. 7, lines 45-48, [plurality of product models], Col. 7, lines 60-61, [pipeline view for producing a set of products]).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R. B.

September 26, 2003

Susanna Diaz
Susanna Diaz
Primary Examiner
A.U.3623